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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/034,446 | 12/26/2001 | Rick K. Southern | D9426 | 1727 |

7590 10/20/2004

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EXAMINER



A, PHI DIEU TRAN

ART UNIT PAPER NUMBER

3637

DATE MAILED: 10/20/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|---|-------------------------------|--|--|
|  Office Action Summary | Application No. 10/034,446 | Applicant(s) SOUTHERN ET AL.  | |
| | Examiner Phi D A | Art Unit 3637 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 August 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3,5-7,10 and 12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3,5-7,10,12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-3, 5-7, 10 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Greenway (2088238) in view of Taylor et al (3740910) and Searer(5570554).

Greenway shows hardwood floor planks (page 2, col 2 lines 24-30) of at least about 3 feet (page 1 col 1 lines 26-29) onto a concrete surface and securing it with an adhesive, the floor having varying thickness at the grooves.

Greenway does not show the adhesive being water resistant, water impermeable adhesive, the boards being nailed to the concrete floor surface at right angles thereto through the boards and through the adhesive layer.

Searer shows a hardwood floor plank boards being nailed to the concrete floor surface at right angles thereto through the boards.

Taylor et al discloses a board (8) being secured to a substructure with nails (12) going through the boards and adhesives (14), the adhesive being water impermeable adhesive (col 1 lines 55-60), the nailing going through the board after the adhesive (14) has been applied to the boards (col 4 lines 54-57).

It would have been obvious to one having ordinary skill in the art at the time of the invention to modify Greenway to show the adhesive being water resistant, water impermeable adhesive as taught by Taylor et al, the boards being nailed to the concrete floor surface at right

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angles thereto through the boards as taught by Searer and through the adhesive layer because having the adhesive being water resistant water impermeable would prevent the adhesive from being damaged by water as taught by Taylor et al, and having nails going through floor boards to the concrete surface at right angles thereto through the boards and the adhesives would enable the adhesive to hold onto the boards while nailing the boards in positions and enable the adhesives to bond the boards in place upon drying without having to have a person holding the boards in place.

Greenway as modified shows all the claimed limitations. The claimed method steps for attaching solid hardwood floor planks to a concrete surface would have been the obvious method of attaching Greenway's structures to a concrete surface.

Response to Arguments

3. Applicant's arguments filed 8/5/04 have been fully considered but they are not persuasive.

With respect to applicant's statements that neither Greenway nor Searer teaches applicant's claimed adhesives, examiner agrees. However, the combination of the above references with Taylor et al, which teach the use of adhesive with nailing, reads on applicant's claimed adhesive. The argument is thus moot.

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

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With respect to combination of references, examiner would like to point out that the 103 combination is based on three references, Greenway, Searer and Taylor et al. The modification of the primary reference Greenway with the other two references as rejected above, read on applicant's claimed limitations.

With respect to applicant's statement to the withdrawal of the rejection of the office action on 1/6/04, examiner would like to point out that the withdrawal was due to the reference Anderson et al, and not due to the references Greenway or Searer.

With respect to applicant's argument to Taylor et al, examiner would like to point out that the combination with the Taylor et al reference would enhance the teaching of Greenway's reference as stated above. Taylor et al teaches attaching a board to a substructure with nails and adhesives. The use of both nails and adhesive would secure the fastening of the board to the substructure. Taylor et al thus teach a way to secure a board and its substructure together. The argument is thus moot.

With respect to applicant's statement to Taylor et al not teaching floor planks attached to concrete surface to form a floor, examiner respectfully points out that the Taylor et al reference teach precisely what is needed for Greenway, which is a way of attaching a structure to its substructure. The argument is thus moot.

With respect to applicant's statement that Taylor et al does not teach applicant's claimed adhesives, examiner respectfully disagrees. Taylor et al teaches exactly the adhesives applicant is claiming. Applicant claims the adhesive being water resistant, water impermeable, Taylor et al teach the adhesives being water proof. By definition in Webster Dictionary → waterproof = impervious to water; covered with a material to prevent permeation by water. As such,

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waterproof reads on applicant's water resistant, water impermeable properties. The argument is thus moot.

4. With respect to applicant's argument that Taylor et al is not analogous, examiner respectfully disagrees. It has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, Taylor et al teaches a way of attaching a board to a substructure. Greenway teaches a way of attaching a board to a substructure and so does Searer. The references are analogous as they all teach a way of attaching a structure to a substructure. The argument is thus moot.

With respect to applicant's statement that Taylor et al's adhesives being different from applicant's claimed adhesives, examiner respectfully disagrees as pointed out above. There is nothing in the claims that differentiate applicant's adhesives from Taylor et al's adhesive. The argument is thus moot.

With respect to applicant's stated commercial success, examiner would like to point out that commercial success is based on a variety of reasons. Commercial success therefore cannot be based upon as the reason for granting a patent. The argument is thus moot.

5. The Declarations of Joseph J. Grady Jr. and Richard P. Hirsch under 37 CFR 1.132 filed 7/6/04 are insufficient to overcome the rejection of claims 1-3, 5-7, 10, 12 based upon Greenway, Searer and Taylor et al as set forth in the last Office action because: the modification of Greenway with Searer and Taylor et al teaches applicant's claimed limitations. To further respond to applicant's Declarations, examiner would like to point out that the combination

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enhances the attachment of Greenway's boards to its substructure. The modification is thus encouraged and motivated. Other arguments in the Declaration are also moot as explained above.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Phi D A whose telephone number is 703-306-9136. The examiner can normally be reached on Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lanna Mai can be reached on 703-308-2486. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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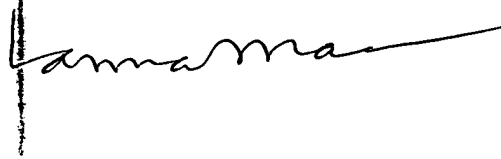
Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Phi Dieu Tran A

PA

10/14/04

LANNA MAI
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600

A handwritten signature in black ink, appearing to read 'Lanna Mai', is written over a vertical line that serves as a signature separator.